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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

KIM, YOUNG J

ART UNIT	PAPER NUMBER
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1637

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/076,555

Applicant(s)

WILLIAMS ET AL.

Examiner

Young J. Kim

Art Unit

1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-51 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 23-51 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 23-40, and 43-51, drawn to an isolated polynucleotide relating to SEQ ID NO: 68, a recombinant host cell comprising the polynucleotide, a vector comprising the polynucleotide, a probe hybridizing thereto, a method of using the polynucleotide to produce a polypeptide, and a method of isolating the homologs of the polynucleotide, classified in class 536, subclass 23.1.
- II. Claim 41, drawn to a library of polynucleotide comprising at least one polynucleotide related to SEQ ID NO: 68, classified in class 536, subclass 24.3.
- III. Claim 42, drawn to a polynucleotide comprising the nucleotide sequence of an insert contained in clone deposited under clone number M00001624A:B06 of ATCC deposit number 207038, classified in class 536, subclass 23.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-III are unrelated to each other. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the Inventions are unrelated for the following reasons. The inventions of Group I and III comprise structurally different sequences. The Invention of Group I relates to a polynucleotide of SEQ ID NO: 68, while the Invention of Group III relates to a polynucleotide of **different sequence** (SEQ ID NO: 95, see page 158 of the specification), resulting in separate searches. The Invention of

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Group II and III are also unrelated because the library of polynucleotide of Group II does not require the polynucleotide of Group III. Lastly, the Inventions of Groups I and II are unrelated because the two inventions comprise different structures, not useable together. For example, the polynucleotide of Group I, as evidenced by the grouped methods, is used to express a polypeptide. A library of polynucleotides, however, comprises a different structure (*i.e.*, a group of polynucleotides), resulting in uses which are not coextensive, such as expression profiling, resulting in searches which are not coextensive in scope, further requiring additional search burden.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group III; and the search required for Group II is not required for Group III, restriction for examination purposes as indicated is proper.

Because inventions of Groups I and II are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Sequence Election Requirement Applicable to Group II

In addition, Group II detailed above reads on patentably distinct combination of sequences. Each combination is patentably distinct because they comprise a group of unrelated sequences, and a further restriction is applied to the Group. Therefore, Applicants must further elect a single combination nucleotide sequence. For example, Applicants must elect a single combination of SEQ ID Numbers and identify the SEQ ID Numbers of the combination in the claims.

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The restriction practice of Group II is provided by MPEP 803.04, example (c), wherein the section states:

“Applications containing only composition claims reciting different combination of individual nucleotide sequences...will be subject to a restriction requirement. Applicants will be required to select one combination for examination. If the selected combination contains ten or fewer sequences, all of the sequences of the combination will be searched. If the selected combination contains more than ten sequences, the combination will be examined following the procedures set forth above for example (B)”

Example (B) states that the presence of one novel and nonobvious sequence within the combination will render the entire combination free of prior art (MPEP 803.04).

Therefore, Applicants must elect a single combination of polynucleotide sequences to which the claimed combination comprises. Further, Applicants are advised to identify up to Ten (10) polynucleotide sequences (within the combination) which are least likely to be found in the prior art, for the examination to be facilitated.

A telephone call was not made to request an oral election to the above restriction requirement due to the complex nature of the requirement (MPEP § 812.01).

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

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application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Inquiries

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Young J. Kim whose telephone number is (571) 272-0785. The Examiner can normally be reached from 8:30 a.m. to 6:00 p.m. Monday through Thursday. If attempts to reach the Examiner by telephone are unsuccessful, the Primary Examiner in charge of the prosecution, Dr. Kenneth Horlick, can be reached at (571) 272-0784. If the attempts to reach the above Examiners are unsuccessful, the Examiner's supervisor, Gary Benzion, can be reached at (571) 272-0782. Papers related to this application may be submitted to Art Unit 1637 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If applicant does submit a paper by FAX, the original copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office. All official documents must be sent to the Official Tech Center Fax number: (703) 872-9306. For Unofficial documents, faxes can be sent directly to the Examiner at (517) 273-0785. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-0507.



Young J. Kim
Patent Examiner
Art Unit 1637
3/17/04